

## REMARKS

Claims 1-36 are pending in the subject application. Claims 18, 20-32, 35, and 36 have been withdrawn by the Examiner from consideration subject to a restriction requirement. Claims 1-17, 19, and 33-34 have been rejected. Applicant has amended independent claims 1 and 33, has canceled claims 17 and 34, and has not added any claims. Accordingly, claims 1-16, 19 and 33 are presently being examined.

In view of the following Amendment and Response, applicant respectfully requests that the Examiner reconsider and withdraw the rejections made in the outstanding Office Action.

### Support for the Amendments

Applicant has amended independent claims 1 and 33 in order more particularly point out and distinctly claim the subject matter of applicant's compartmentalized storage system for temporarily storing and subsequently mixing at least two different substances. Specifically, applicant has canceled claim 17 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. Applicant has entered these amendments in order to overcome the Examiner's rejections.

Applicant has also amended the description of Figure 2 in the specification to recite that the first and the second compartments are attached to each other by more than two common sides. These amendments to the specification are fully supported in the specification as originally filed, for example in claim 6, and thus no new matter is introduced by these amendments in accordance with 35 U.S.C. Section 132. Accordingly, applicant requests entry of these amendments.

Applicant has also amended the Figures to provide a replacement Figure 2, with the proposed changes marked in red, to illustrate that the first and the second compartments are attached to each other by more than two common sides. These amendments to the Figures are fully supported in the specification as originally filed, for example in claim 6, and thus no new matter is introduced by these amendments in accordance with 35 U.S.C. Section 132. Accordingly, applicant requests entry of these amendments.

**Office Communication Dated 3 February 2004**

In the Office Communication dated 3 February 2004, the Examiner stated that applicants' reply filed on 1/23/04 is not fully responsive to the prior Office Action because applicant has incorporated the limitation of claim 18 into the independent claims while claim 18 was restricted out in the previous Office Action. The Examiner argued that incorporation would force the Examiner to consider the previous non-elected claim 18 and hence the amended claims will not be considered at this time.

The Examiner also stated that applicant's proposed Figure 2 does not have red ink indicating the proposed changes and applicant should submit another proposed drawing with red ink specifying the addition and changes.

**Restriction Requirement**

In the Examiner's restriction requirement dated 18 July 2003, the Examiner restricted the claims to the following groups.

I. Claims 1-19, drawn to a compartmentalized mixing container utilizing a frangible seal, classified in class 206, subclass 222.

II. Claim 20-32, drawn to a compartmentalized mixing food container, classified in class 426, subclass 120.

III. Claims 33-34, drawn to a method of using a compartmentalized mixing container utilizing a frangible seal, class 366, subclass 130.

Applicant timely traversed the restriction requirement and elected claims 1-19 in Group I. After review of the original restriction requirement, the present Examiner issued a new restriction requirement dividing the claims among Species I (Figure 1), Species II (Figure 2), and Species III (Figure 3). Because applicant had already elected the first set of claims that includes the wipes and two other substances within the container, the present Examiner stated that Figures 1 and 2 will be examined together at this time. Hence, the present Examiner examined claims 1-17, 19, and 33-34 and withdrew claims 18, 20-32 and 35-36 as a non-elected embodiment.

Applicants traverse the present restriction requirement withdrawing claim 18. Applicant timely traversed the original restriction requirement and elected claims 1-19 in Group I. Moreover, the Summary in the Office Action dated 29 October 2003 states that claims 20-32, 35, and 36 were withdrawn from consideration, and claims 1-19, and 33-34 were rejected.

## **Drawings**

The Examiner has objected to the drawings on the basis that the drawings must show every feature of the invention specified in the claims. The Examiner states that the first and second compartment attached to each other by more than two common sides must be shown or the features canceled from claim 6. Applicants' replacement Figure 2, submitted herewith, and amendment to the specification obviates the Examiner's objection.

As set out above, applicants have enclosed replacement Figure 2, with proposed changes marked in red, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to

each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Hence, the Examiner's objection to the drawings should be withdrawn.

**Objection to the Specification and Rejection of Claim 6 Under 35 U.S.C. Section 112, first paragraph.**

The Examiner has objected to the specification and under 35 U.S.C. Section 112, first paragraph as failing to provide an adequate written description of the invention, and failing to adequately teach how to make and/or use the invention. The Examiner states that the specification does not disclose the first and second compartment attached to one another on more than two common sides. The Examiner has rejected claim 6 under 35 U.S.C. Section 112, first paragraph, for the reasons set forth in the objection to the specification. Applicants' replacement Figure 2 submitted herewith and amendment to the specification to describe replacement Figure 2, obviates the Examiner's objection and rejection.

As set out above, applicants have enclosed replacement Figure 2, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Hence, the Examiner's objection to the specification and rejection of claim 6 under 35 U.S.C. Section 112, first paragraph, should be withdrawn.

**Rejection of Claims 6 and 33-34 rejected under 35 U.S.C. Section 112, second paragraph.**

The Examiner has rejected claims 6 and 33-34 under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the specification does not disclose the first and second compartment attached to one another on more than two common sides. The Examiner further states that in claim 33, the first occurrence of "the tearable seal" lacks proper antecedent basis, and in claim 34, the tearable seal appears to be of the same seal as claim 33. Applicants' new Figure 2A submitted herewith and amendment to the specification to describe Figure 2A, and amended claim 33 obviates the Examiner's objection.

As set out above, applicants have enclosed replacement Figure 2, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Applicant has canceled claim 34 and incorporated the subject matter therein into independent claim 33. Claim 33 now recites that the first storing compartment comprises "a tearable seal".

Hence, the Examiner's rejection of claims 6 and 33-34 under 35 U.S.C. Section 112, second paragraph, should be withdrawn.

Rejection of Claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being Anticipated by *Kasianovitz et al.*

The Examiner has rejected claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being anticipated by United States patent no. 5,616,337 (*Kasianovitz et al.*). The Examiner states that *Kasianovitz et al.* discloses a package with two chambers, one chamber holding a liquid and the other chamber holding a pad and powder or a pad and liquid. The Examiner argues that a breakable seal 18 allows the mixture of the two contents after it is ruptured and the powder that dissolves in the liquid would produce a foaming reaction. Applicants' claims as amended obviate the Examiner's rejections.

Applicants' claim 1, as amended, recites a compartmentalized storage system for temporarily storing and subsequently mixing at least two different substances. The system comprises (a) a first storing compartment having a front and a back and a plurality of sides, defining a first cavity portion, and a tearable seal, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment. The first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments. Applying force to the frangible seal will break the frangible seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment.

Applicants' claim 33, as amended, recites a method for using a compartmentalized storage system to temporarily store and subsequently mix at least two different substances. The method comprises the steps of (A) providing a



compartmentalized storage system comprising (a) a first storing compartment having a front and a back, a plurality of sides, defining a first cavity portion, and a tearable seal, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment. The first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments. Applying force to the frangible seal will break the frangible seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment. The method further comprises (B) applying force to the frangible seal to break the seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment; (C) applying force to the tearable seal to break the seal; and (D) removing the solid sorbing substrate, mixed with the first substance and the second substance, through the broken tearable seal in the first storing compartment.

The *Kasianovitz et al.* reference discloses a unit dose package comprising a web having two compartments separated by a frangible seal. A liquid is contained within the first compartment and an applicator is contained within the second compartment separate from the web.

The Examiner has not rejected claims 17 and 34. As set out above, applicant has canceled claim 17 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal". Applicant has similarly canceled claim 34

and incorporated the subject matter therein into independent claim 33. *Kasianovitz et al.* does not teach a tearable seal in the first storing compartment.

Hence, the Examiner's rejection of claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being anticipated *Kasianovitz et al.* should be withdrawn.

**Rejection of Claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of *Stupar et al.***

The Examiner has rejected claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of United States patent no. 5,353,927 (*Stupar et al.*). The Examiner states that *Kasianovitz et al.* does not show more than one point of attachment but that *Stupar et al.* suggests an arrangement of compartments wherein the first and second compartments are connected at two locations for the mixing of the contents. The Examiner states that such an arrangement allows the compartments to be sealed tight to one another. Applicants' claims as amended obviate the Examiner's rejections.

The *Stupar et al.* reference discloses a plural compartment package for mixing materials. The package comprises a first sheet of packaging material and a second sheet of packaging material overlapping the first sheet of packaging material. The first and second sheets of packaging material are joined together such that an area is defined there between. A third sheet of packaging material is located between and joined to the first and second sheets of packaging material such that a first compartment for holding a first material is defined between the third sheet of packaging material and the first sheet of packaging material. A second compartment for holding a second material is defined between the second and third sheets of packaging material. The third sheet of packaging material has a weakened area which is rupturable upon the application of pressure for enabling the first and second materials to mix together. A non-porous,



rupturable cap means is secured to the third sheet of packaging material and overlays the weakened area of the third sheet of packaging material for preventing discharge of the first material from the first compartment until the application of the pressure ruptures both the weakened area of the third sheet of packaging material and the cap means whereby the first material is discharged from the first compartment into the second compartment for mixing with the second material.

As set out above, applicant has canceled claim 17 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. Neither *Kasianovitz et al.* nor *Stupar et al.* teach a tearable seal in the first storing compartment.

Hence, the Examiner's rejection of claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of *Stupar et al.* should be withdrawn.

**Rejection of Claims 6, 10, 12-17, and 34 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of "Official Notice".**

The Examiner states that claims 6, 10, 12-17, and 34 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of "Official Notice". The Examiner states that although *Kasianovitz et al.* shows only one common side of attachment, it would have been obvious to arrange the compartments in a manner to have multiple connecting points for the compartments to ensure the sealability of the sides. With respect to the different contents and reactions, the Examiner argues that it would have been obvious to provide the desired articles or agent within the respective compartments to produce the desired result. With respect to

the tearable seal, the Examiner argues that although the tearable seal shown in *Kasianovitz et al.* does not extend to the first compartment, it is conventionally known to provide a tearable seal within the compartment to allow dispensing of that particular substance only. Applicants traverse the Examiner's rejection of claims 6, 10, 12-17, and 34 over *Kasianovitz et al.* in view of "Official Notice".

Official notice without documentary evidence to support an Examiner's conclusion is permissible only in some circumstances. While "Official Notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. Section 1.113. Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. M.P.E.P. 2144.03[A]

It would not be appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. M.P.E.P. 2144.03[A]

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 U.S.P.Q.2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). M.P.E.P. 2144[B]

In summary, any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the Examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 U.S.P.Q. 424. M.P.E.P. 2144[C].

Applicants traverse the Examiner's finding of Official Notice. Specifically, the Examiner's concedes that the tearable seal shown in *Kasianovitz et al.* does not extend to the first compartment. Nevertheless, the Examiner argues that it is conventionally known to provide a tearable seal within the compartment to allow dispensing of that particular substance but the Examiner provides no reference to support this position.

Applicants' tearable seal in the first compartment provides a means to easily remove the solid sorbing substrate after the second substance in the second storing compartment is mixed with the solid sorbing substrate and the first substance in the first storing compartment. None of the references of record show a tearable seal in the first compartment, which seal provides a means to easily remove the solid sorbing substrate after the mixing step is over. Accordingly, applicants' tearable seal in the first compartment is not common knowledge or well-known in the art since none of the references cited by the Examiner show this feature. Hence, applicants have traversed the Examiner's assertion of Official Notice and the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. If

the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. 37 C.F.R. Section 1.104(d)(2). M.P.E.P. 2144[C]

The Examiner cites no reference teaching or suggesting the use of applicant's tearable seal in the first storing compartment. In the absence of such teachings, the Examiner cannot assert that "it is conventionally known to provide a tearable seal within the compartment to allow dispensing of that particular substance only".

[A]s a matter of law under 35 U.S.C. Section 103, the Examiner must substantiate his "suspicions" on the basis of facts drawn from proper prior art. The issue to be resolved requires more than "suspicions;" it requires facts.... The provisions of section 103 must be followed realistically to develop the factual background against which the section 103 determination must be made. All of the facts must be considered.... *In re Lunsford*, 357 F.2d 380, 391, 148 U.S.P.Q. 716, 725 (C.C.P.A. 1966) [emphasis in original].

As set out above, applicant has canceled claims 17 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. *Kasianovitz et al.* does not teach a tearable seal in the first storing compartment.

Accordingly, the Examiner' rejection of claims 6, 10, 12-17, and 34 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of "Official Notice" should be withdrawn.


The provisions of Section 103 must be followed realistically to develop the factual background against which the Section 103 determination must be made. It is not proper within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The references of record fail to teach or suggest applicant's invention as a whole.

Obviousness of a composition or process must be predicated on something more than it would be obvious "to try" the particular component recited in the claims or the possibility it will be considered in the future, having been neglected in the past. *Ex parte Argabright et al.* (POBA 1967) 161 U.S.P.Q. 703. There is usually an element of "obvious to try" in any research endeavor, since such research is not undertaken with complete blindness but with some semblance of a chance of success. "Obvious to try" is not a valid test of patentability. *In re Mercier* (CCPA 1975) 515 F2d 1161, 185 U.S.P.Q. 774; *Hybritech Inc. v. Monoclonal Antibodies, Inc.* (CAFC 1986) 802 F2d 1367, 231 U.S.P.Q. 81; *Ex parte Old* (BPAI 1985) 229 U.S.P.Q. 196; *In re Geiger* (CAFC 1987) 815 F2d 686, 2 U.S.P.Q.2d 1276. *In re Dow Chemical Co.* (CAFC 1988) F2d, 5 U.S.P.Q.2d 1529. Patentability determinations based on that as a test are contrary to statute. *In re Antonie* (CCPA 1977) 559 F2d 618, 195 U.S.P.Q. 6; *In re Goodwin et al.* (CCPA 1978) 576 F2d 375, 198 U.S.P.Q. 1; *In re Tomlinson et al.* (CCPA 1966) 363 F2d 928, 150 U.S.P.Q. 623. A rejection based on the opinion of the Examiner that it would be "obvious to try the chemical used in the claimed process which imparted novelty to the process does not meet the requirement of the statute (35 U.S.C. 103) that the issue of obviousness be based on the subject matter as a whole. *In re Dien* (CCPA 1967) 371 F2d 886, 152 U.S.P.Q. 550; *In re Wiaains* (CCPA 1968) 397 F2d 356, 158 U.S.P.Q. 199; *In re Yates* (CCPA 1981) 663

F2d 1054, 211 U.S.P.Q. 1149. Arguing that mere routine experimentation was involved overlooks the second sentence of 35 USC 103. *In re Saether* (CCPA 1974) 492 F2d 849, 181 U.S.P.Q. 36. The issue is whether the experimentation is within the teachings of the prior art. *In re Waymouth et al.* (CCPA 1974) 499 F2d 1273, 182 U.S.P.Q. 290. The fact that the prior art does not lead one skilled in the art to expect the process used to produce the claimed product would fail does not establish obviousness. *In re Dow Chem. Co.* (CAFC 1988) 5 U.S.P.Q.2d 1529.

In view of the foregoing Amendment and Response, applicants request reconsideration pursuant to 37 C.F.R. Section 112 and allowance of the claims pending in this application. Applicant requests the Examiner to telephone the undersigned attorney should the Examiner have any questions or comments which might be most expeditiously handled by a telephone conference. No fee is deemed necessary in connection with the filing of this Amendment and Response. If any fee is required, however, authorization is hereby given to charge the amount of such fee to Deposit Account No. 13-4822.

Respectfully submitted,

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